



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : LEIBER ET AL.

SERIAL NO. : 08/976,820

FILED : November 24, 1997

FOR : USE OF AN ADHESIVE TAPE SECTION

ART UNIT : 1771

EXAMINER : John J. Guarriello

Hon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 CFR §1.132

SIR:

I, Bernd Lühmann, hereby declare as follows:

1. I am a co-inventor of the invention disclosed and claimed in the above-identified application. In addition, I am a co-inventor of the Lühmann reference which was relied upon in part to formulate the obviousness rejection of claims 20-31.
2. I graduated in 1985 from the Technical University of Clausthal Zellerfeld, Germany, in Physical and Macromolecular Sciences. Since 1987, I have been employed by Beiersdorf AG, and now its subsidiary, tesa AG, both of Hamburg, Germany, where I am responsible for the development of adhesive tapes.

3. I have been informed of the Decision on Appeal dated March 26, 2003, where the rejection of claims 20-31 over the combined disclosures of Lühmann and Cole was affirmed. I have also been informed that a Request for Rehearing under 37 CFR 1.197(b) must specifically state the points of law or fact which the appellants feels were misapprehended or overlooked in the Board's decision. I believe that there are points of fact which were misapprehended or overlooked when considering the teachings of our invention as well as points of fact which were misapprehended or overlooked when considering the teachings of the Lühmann and Cole references.
4. I have been informed that a prior art reference may be considered for all that it teaches and not just what is claimed. However, I have also been informed that a prior art reference must be considered in its entirety including portions that would lead away from the claimed invention.
5. In this regard, I believe that certain facts have been misapprehended or overlooked.
6. No weight or consideration given toward facts directed to a "teaching away"
7. On page 4 (second paragraph of the "Opinion" section) of the Board's decision, a particular section of the Lühmann reference is cited (i.e. col. 2, lines 27-42 and col. 2, line 57 to col. 3, line 10) for alleged support for a teaching of a releasable double-sided adhesive tape which can be removed via pulling tabs attached thereto in the bond plane.

8. However, this particular section of the Lühmann reference is directed toward a specific embodiment of the invention taught by Lühmann. When considering the broader object of Lühmann's invention, it is stated:

"The object of the present invention was to provide adhesive films for temporary bonds which are totally within the region of the bond joint after bonding, i.e. are "invisible" but which nevertheless preferably allow separation of the bonded objects in a simple manner without damage and without leaving a residue. In particular, *a tab* for pulling the adhesive film out of the bond plane *should not be necessary*." (see col. 1, lines 57-63)

9. This teaching is important because it appears that the rationale for the Board's decision is that either "It can be inferred..." or "...it is well within the ambit..." (see page 7 of Board decision) that one of ordinary skill in the art could provide an appropriate number of grip tabs not that the combination of Lühmann and Cole actually explicitly teach the appropriate number of grip tabs. Obviously, such an argument is easier to make if no contradictory evidence is present or no other differences need to be accounted for (e.g. Cole and the shape of the adhesive), but when also viewed in the light of a contradictory statement intended for the invention of Lühmann as a whole, I do not believe that providing an appropriate number of grip tabs would have been inferred or would have been well within the ambit of one of ordinary skill in the art. At the very least, an explanation as to why it was not necessary to consider this contradictory statement should have been presented in the Board's decision.

10. "Tab" disclosure in Lühmann has been misapprehended and also represents a "teaching away" or at worst represents an ambivalent teaching which is not supportive of the Board's "inference"

11. In the reasons supporting the combination of Lühmann and Cole, the Board stated on page 7 that “it is well within the ambit of one of ordinary skill in the art to provide an appropriate number of grip tabs...*to provide contingent bases in the case of failure of one or more grip tabs in removing the adhesive tapes* since Lühmann teaches that the grib (sic) tabs can be pulled at any angle and are used to remove the residues of the adhesive tapes as indicated *supra*.” (bold and italics added for emphasis)
12. However, there is no teaching which can be gleaned from the combination of Lühmann and Cole that this is necessary or desired. Moreover, the tabs of Lühmann function to remove residue not toward releasing the bond between an object and a substrate. In fact, when reading the entire paragraph from Lühmann (col. 2, lines 57 - col. 3, line 3) which the Board merely cited four lines (which is shaded below), one of ordinary skill in the art would have read the Lühmann reference to be at best rather ambivalent about the need for *any* tabs, much less multiple tabs:

“In these embodiments according to the invention with an adhesive film of the rather more classical type of a self-adhesive composition as widely employed for adhesive tapes, the separation of the pulled-apart parts is less easy after breaking the bond. *However, this is relatively unimportant for some applications, in particular if the residues can remain on the substrates without causing any problems.* However, if in this and other cases the residues are to be more easily removable, a tab is recommended in each case to enable easier pulling on the residue. Such a tab can be designed, in particular, so that non-adhesive areas extend around an edge of the piece of adhesive film, *for example a few millimeters beyond the adhesive area beneath.*”

13. The Board misapprehended that one of ordinary skill in the art would “infer” that grip tabs can be provided to each and every side of the tape
14. Referring again to the shaded passage in 12. above, as I presumably would be considered one of ordinary skill in the art, I assert that the Board misapprehended that one of ordinary skill in the art would “infer” that a recitation wherein “...*a tab* is recommended in each case to enable easier pulling on the residue, *a tab* can be designed, *in particular*, so that non-adhesive areas extend around *an edge* of the piece of adhesive film, *for example a few millimeters beyond the adhesive area beneath.*” would be construed to be suggestive “that grip tabs can be provided to each and every side or some of the sides of a given geometrically shaped adhesive tape to substantially or fully surround the tape’s edge.” (from page 7, lines 3-6 of the Board’s decision)
15. The broadest recitation is singular (“...*a tab* is recommended...*a tab* can be designed”), an embodiment of this recitation is still singular (“*in particular*, so that non-adhesive areas extend around *an edge* of the piece of adhesive film) and an example of this embodiment is directed towards the practice of removing residue and is not directed toward releasing the bond between an object and a substrate (*for example a few millimeters beyond the adhesive area beneath*). None of these disclosures would “infer” to one of ordinary skill in the art to use multiple tabs equaling the number of edges, or to supply grip tabs for each and every edge. Clearly, the portion of Lühmann relied on by the Board is only talking about the design of a single tab on a single edge. The same type of tab could, of course, be placed at each an every edge, but there is no teaching or

suggestion in Lühmann to do so, so this aspect of the present invention cannot be inferred from Lühmann.

16. Even if Board was also relying on combining the teaching of Example 8 of Lühmann, this does not buttress the Board's holding of inference. Example 8 discloses a film "...where 5 mm of the release films *are folded around the adhesive film* at each end of the adhesive films and thus form tabs...Removal of residues of adhesive films from the substrate and previously bonded article without leaving a residue is nevertheless possible *if the siliconized polypropylene release films are folded up* and the adhesive film parts are removed by slow pulling parallel to the bond plane." This disclosure only serves to cement the fact that there are fewer tabs than edges and that what constitutes a "tab" in the Lühmann reference is used to remove residue and is not directed toward releasing the bond between an object and a substrate. This folding of the release film around a single edge to form a tab, i.e., complementary non-adhesive areas on the top and bottom faces of that end of the tape, is exactly what is being alluded to by Lühmann at column 2, last line, through column 3, first two lines. There is nothing in Lühmann that supports the Board's findings that it can be "inferred" or that it is "well within the ambit" to use multiple tabs equaling the number of edges.

17. Summary and Conclusion

18. With regard to the Board's "inferred from the teachings" and "well within the ambit" arguments in support of obviousness, it appear incongruous that these specific disclosures such as contradictory evidence ("tab for pulling...should not be necessary"),

ambivalent evidence (“However, this is relatively unimportant for some applications”), explicit recitation of a limitation which differs from the claimed invention (“a tab...an edge...”) and an explicit example which supports the explicit recitation of that limitation cannot be ignored. Respectfully, a person having ordinary skill in the art, at the time the present invention was made, given Lühmann and Cole, would not have made the inferences the Board found they would have made, and would not have found the provision of a number of grip tabs equal to the number of edges to be within the ambit of the skilled artisan, and therefore, also would not have found the present invention to have been obvious.

The final paragraph of the Board’s decision stated that the “evidence of obviousness, on balance, outweighs the evidence of nonobviousness proffered by the appellants.” It is believed that when the foregoing is considered/re-considered, the balance of evidence will shift to non-obviousness.